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| APPLICATION NO.                    | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|------------------------------------|-------------|----------------------|---------------------|------------------|
| 09/920,895                         | 08/02/2001  | Peter A. Goode       | 22.1410             | 9846             |
| 35204                              | 7590        | 03/24/2009           |                     |                  |
| SCHLUMBERGER RESERVOIR COMPLETIONS |             |                      | EXAMINER            |                  |
| 14910 AIRLINE ROAD                 |             |                      | BEACH, THOMAS A     |                  |
| ROSHARON, TX 77583                 |             |                      |                     |                  |
|                                    |             |                      | ART UNIT            | PAPER NUMBER     |
|                                    |             |                      | 3671                |                  |
|                                    |             |                      | NOTIFICATION DATE   | DELIVERY MODE    |
|                                    |             |                      | 03/24/2009          | ELECTRONIC       |

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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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3  
4 BEFORE THE BOARD OF PATENT APPEALS  
5 AND INTERFERENCES  
6

7  
8 *Ex parte* PETER A. GOODE, ANDREW GOULD,  
9 ALAN CHRISTIE and CHARLES E. VISE, JR.  
10

11  
12 Appeal 2008-5605  
13 Application 09/920,895  
14 Technology Center 3600  
15

16  
17 Decided:<sup>1</sup> March 20, 2009  
18  
19

20 *Before:* WILLIAM F. PATE, III, JENNIFER D. BAHR and  
21 FRED A. SILVERBERG, *Administrative Patent Judges.*  
22  
23 SILVERBERG, *Administrative Patent Judge.*  
24  
25

26 DECISION ON APPEAL  
27

28 STATEMENT OF THE CASE

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<sup>1</sup> The two month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

Appellants appeal under 35 U.S.C. § 134 (2002) from a rejection of claims 10-12, 25, 26, 28, 29, 44-48, 50 and 51. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

#### SUMMARY OF DECISION

We REVERSE.

#### THE INVENTION

The Appellants' claimed invention is directed to a subsea well having a self-contained intervention (maintenance and repair) system (Spec.1:11-12). Claim 10, reproduced below, is representative of the subject matter on appeal.

10. A method comprising:
  - halting the flow of fluid in a well;
  - deploying a tool from within the well while the fluid is halted;
  - allowing the tool to free fall in the well while the fluid is halted; and
  - resuming the flow to retrieve the tool.

#### THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

|         |                 |              |
|---------|-----------------|--------------|
| Kilgore | US 6,182,765 B1 | Feb. 6, 2001 |
|---------|-----------------|--------------|

1 The following rejection<sup>2</sup> by the Examiner is before us for review:  
2 Claims 10-12, 25, 26, 28, 29, 44-48, 50 and 51 are rejected under 35  
3 U.S.C. § 102(b) (2002) as being anticipated by Kilgore.

4  
5 ISSUE

6 The issue before us is whether the Appellants have shown that the  
7 Examiner erred in rejecting claims 10-12, 25, 26, 28, 29, 44-48, 50 and 51  
8 over Kilgore. The issue turns on whether Kilgore discloses halting the flow  
9 of fluid in the well and deploying a tool within the well while the fluid is  
10 halted as recited in claim 10.

11  
12 FINDINGS OF FACT

13 We find that the following enumerated findings are supported by at  
14 least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d  
15 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for  
16 proceedings before the Office).

- 17 1. Kilgore discloses a system and a method for deploying a plurality  
18 of tools in a subterranean well 100, wherein the system and method  
19 comprise a master valve 220, a production valve 180, a servicing  
20 and completion system 240, wherein the servicing and completion  
21 system comprises a tool displacement mechanism 310 and a tool  
22 selector 320 (col. 5, ll. 19-22), wherein a tool string 315 comprises  
23 a tool 327 and the tool displacement mechanism 310 (col. 5, ll. 54-

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<sup>2</sup> The Grounds of Rejection section of the Examiner's Answer (Ans. 3) stated that claim 13 was rejected under 35 U.S.C. § 102. Claim 13 was canceled in a Response To Restriction requirement dated March 15, 2004 (Br. 5). Accordingly, claim 13 is not involved in this appeal.

56), and a computer 340 for controlling the tool displacement mechanism 310.

2. Kilgore further discloses that the master valve 220 allows complete shut-down of the well production, if necessary (col. 5, ll. 5-6).

3. Kilgore still further discloses that the servicing and completion system 240 may be operated while the well is still in operation (col. 5, ll. 10-16).

4. Kilgore still further discloses that the computer 340 commands the master valve 220 to open, and the tool string 315 is allowed to free-fall at least some distance into the well 100 (col. 5, ll. 59-61).

5. Kilgore still further discloses that when the tool displacement mechanism 310 determines that the tool string 315 is in the proper location, the tool displacement mechanism 310 may operate to open or close the production valve 180 (col. 6, ll. 3-11).

6. Kilgore still further discloses that after the task is completed by the tool 327, well pressure carries the tool string 315 back to the surface (col. 6, ll. 11-14 and col. 7, ll. 1-6).

7. The ordinary meaning of the word “free fall” includes “the condition of unrestrained motion in a gravitational field.”

*Merriam-Webster’s Collegiate Dictionary* (10<sup>th</sup> ed. 1996).

#### PRINCIPLES OF LAW

Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention. *RCA Corp. v. Applied Digital Data Sys., Inc.*, 730 F.2d 1440, 1444 (Fed. Cir. 1984). In other words, there must be no

1 difference between the claimed invention and the reference disclosure, as  
2 viewed by a person of ordinary skill in the field of the invention. *Scripps*  
3 *Clinic & Research Found. v. Genentech Inc.*, 927 F.2d 1565, 1576 (Fed. Cir.  
4 1991). It is not necessary that the reference teach what the subject  
5 application teaches, but only that the claim read on something disclosed in  
6 the reference, i.e., that all of the limitations in the claim be found in or fully  
7 met by the reference. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 772  
8 (Fed. Cir. 1983), *cert. denied*, 465 U.S. 1026 (1984).

9 "It is well settled that a prior art reference may anticipate when the  
10 claim limitations not expressly found in that reference are nonetheless  
11 inherent in it. Under the principles of inherency, if the prior art necessarily  
12 functions in accordance with, or includes, the claimed limitations, it  
13 anticipates." *In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1349 (Fed. Cir.  
14 2002) (citations and internal quotation marks omitted). "Inherency,  
15 however, may not be established by probabilities or possibilities. The mere  
16 fact that a certain thing may result from a given set of circumstances is not  
17 sufficient." *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (citations  
18 and internal quotation marks omitted).

19 Once a *prima facie* case of anticipation has been established, the  
20 burden shifts to the Appellant to prove that the prior art product does not  
21 necessarily or inherently possess the characteristics of the claimed product.  
22 *In re Best*, 562 F.2d 1252, 1255 (CCPA 1977) ("Where, as here, the claimed  
23 and prior art products are identical or substantially identical, or are produced  
24 by identical or substantially identical processes, the PTO can require an  
25 applicant to prove that the prior art products do not necessarily or inherently  
26 possess the characteristics of his claimed product."). See also *In re Spada*,

1 911 F.2d 705, 708-09 (Fed. Cir. 1990). "[A] prima facie case of anticipation  
2 [may be] based on inherency." *In re King*, 801 F.2d 1324, 1327 (Fed. Cir.  
3 1986).

4  
5 ANALYSIS

6 Appellants contend that Kilgore does not implicitly or inherently  
7 disclose halting the flow of fluid in the well 100 in connection with the  
8 deployment of the tool string 315 (Br. 9-12), and that the language "free-  
9 fall" in Kilgore has no bearing on whether or not flow is present in the well  
10 (Br. 10). The ordinary meaning of the word "free fall" includes "the  
11 condition of unrestrained motion in a gravitational field." Merriam-  
12 Webster's Collegiate Dictionary (10th ed. 1996) (Fact 7). Kilgore discloses  
13 that the servicing and completion system 240 may be operated while the  
14 well 100 is still in operation (col. 5, ll. 10-16) (Fact 3). We find that fluid  
15 flows in an operating well 100 (Fact 2). In Kilgore, both the tool string 315  
16 and the servicing and completion system 240 include the tool displacement  
17 mechanism 310 (Fact 1). Therefore, we find that the servicing and  
18 completion system 240 also includes the tool string 315. Further, we find  
19 that since the operation of the servicing and completion system 240 includes  
20 the tool string 315, the tool string 315 may be operated while the well is still  
21 in operation with fluid flowing in the well 100. Therefore, we find that  
22 when the tool string 315 is allowed to free-fall (Fact 4), fluid may be flowing  
23 in the well 100. We do not agree with the Examiner's analysis (Ans. 3-5)  
24 and find that Kilgore does not implicitly or inherently disclose halting the  
25 flow of fluid in the well 100 in connection with the deployment of the tool  
26 string 315. We conclude that Kilgore does not disclose halting the flow of

fluid in a well; deploying a tool while the fluid is halted; allowing the tool to free fall in the well while the fluid is halted; and resuming the flow to retrieve the tool as called for in claims 10 and 44, and claims 11, 12, 25, 26, 28, 29, 45-48, 50 and 51 depending from claims 10 and 44, respectively. Therefore, we conclude that the Examiner erred in rejecting claims 10-12, 25, 26, 28, 29, 44-48, 50 and 51 over Kilgore. We reverse the rejection of claims 10-12, 25, 26, 28, 29, 44-48, 50 and 51 under 35 U.S.C. § 102 thereof.

#### CONCLUSION OF LAW

We conclude that the Appellants have shown that the Examiner erred in rejecting claims 10-12, 25, 26, 28, 29, 44-48, 50 and 51 under 35 U.S.C. § 102(b) as being anticipated by Kilgore.

#### DECISION

The decision of the Examiner to reject claims 10-12, 25, 26, 28, 29, 44-48, 50 and 51 over Kilgore is reversed.

#### REVERSED

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